

Remarks/Arguments

Claims 86-103 are now pending in this application. In the February 1, 2010, Office Action, claims 86-103 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,298,327 to Hunter (hereinafter “*Hunter*”), in view of U.S. Patent No. 6,061,660 to Eggleston, et al. (hereinafter “*Eggleston*”). Claims 98-103 were also rejected under 35 U.S. C. §101 because the independent claim allegedly fails to meet the machine-or-transformation test.

By this amendment, claims 86, 92, and 98-103 have been amended. No claims have been cancelled and no new claims have been added. Following entry of this amendment, claims 86-103 will be pending in the present application. For the reasons set forth below, Assignee respectfully requests reconsideration and immediate allowance of this application.

I. Examiner Interview Summary

The Assignee first wishes to express their sincere appreciation for the time that Examiner Ouellette spent with Assignee’s attorneys, Shabbi Khan and Jodi Hartman, during a telephone discussion on April 21, 2010, regarding the outstanding Office Action. During that conversation, the Assignee’s attorneys discussed possible claim amendments regarding the independent claims, similar to those provided above, which may further prosecution of the application. The Assignee respectfully requests that Examiner Ouellette carefully consider the claim amendments made in this response.

II. Claim Rejections under 35 U.S.C. §101

Claims 98-103 were rejected under 35 U.S.C. §101 for failing to meet the machine-or-transformation test. In an effort to advance prosecution, claims 98-103 have been amended to include the language “through the computer” to more clearly illustrate that the recitations of these claims are tied to a machine. By way of these amendments, claims 98-103 meet the requirements of 35 U.S.C. §101. Accordingly, withdrawal of the rejection is respectfully requested.

III. Claim Rejections Under 35 U.S.C. §103 Over *Hunter* and *Eggleston*

Claims 86-103 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. This rejection is respectfully traversed.

Independent Claim 86

Claim 86 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. The combined teachings of *Hunter* and *Eggleston* do not teach, suggest, or describe each and every recitation of claim 86. As amended, claim 86 recites, *inter alia*,

receiving a notification that an intellectual property asset filing has occurred, the intellectual property asset filing based at least in part on an innovation disclosure of the plurality of innovation disclosures associated with the at least one innovator of the plurality of innovators;
in response to receiving the notification that the intellectual property asset filing has occurred, processing a filing gift for the at least one innovator of the plurality of innovators;
receiving a notification that an issuance associated with the intellectual property asset filing has occurred;
in response to receiving the notification of the issuance, processing an issuance gift for the at least one innovator of the plurality of innovators.

Support for this amendment can be found on at least page 197, lines 1-10 of the specification of the Assignee's patent application.

Hunter describes a system that enables inventors to adequately disclose the characteristics of their invention to their technology manager and research sponsor, as well as their patent professional. *Hunter*, however, does not disclose the recitation of amended claim 86 as set forth above. Specifically, *Hunter* does not describe or suggest receiving any notifications that an intellectual property asset filing has occurred, let alone, processing a disclosure gift for at least one innovator in response to receiving the notification that the intellectual property asset

filing has occurred. Furthermore, the cited reference does not suggest or describe receiving any notifications that an intellectual property asset issuance has occurred, or processing an issuance gift for at least one innovator in response to receiving the notification that the intellectual property asset filing has occurred of receiving a notification that an intellectual property asset filing has occurred, as encompassed by amended claim 86. Although *Hunter* does disclose the phrase "Awards" in Table 3 of *Hunter*, a mere mention of the term does not, in any way, suggest or describe the recitation of amended claim 86 as set forth above.

Eggleston generally describes a system for providing incentive programs over a computer network in which a host may provide sponsoring companies with the capability to buy prepackaged or self-built incentive programs. The Office Action contends that *Eggleston* discloses the creation of employee incentive programs, which includes tracking/automated fulfillment of non-monetary reward distribution data. Further, the Office Action contends that *Eggleston* at Fig.20, C8, L13-20, C31 discloses that the awards are issued to employees for job related activities. However, none of the cited portions of *Eggleston* disclose or even suggest that awards are issued to employees for job related activities. Therefore, the Assignee respectfully requests that a subsequent Office Action, if required, specifically cite a portion of *Eggleston* that discloses that awards are issued to employees for job related activities. Even if, for sake of argument, *Eggleston* somehow describes that awards are issued to employees for job related activities, it does not follow that *Eggleston* discloses processing disclosure gifts for at least one innovator in response to receiving a notification that an intellectual property asset filing has occurred. In addition, *Eggleston*, like *Hunter*, also does not disclose or suggest processing an issuance award for at least one innovator in response to receiving a notification that an issuance associated with the intellectual property asset filing has occurred. Accordingly, *Hunter* and *Eggleston* do not, separately or together, teach, suggest, or describe the recitation of amended claim 86 as set forth above.

In addition, the Assignee has amended claim 86 to further clarify one aspect of the present disclosure. As amended, claim 86 recites, *inter alia*, "tracking the filing gift and the issuance gift given to the at least one innovator of the plurality of innovators for the intellectual property asset filing and the issuance." The Office Action contends that *Eggleston* discloses the creation of employee incentive programs, which includes tracking/automated fulfillment of non-monetary reward distribution data. As described above, *Eggleston* has nothing to do with

intellectual property related matters, and therefore, cannot teach, suggest, or describe tracking disclosure gifts and issuance gifts given to the at least one innovator of the plurality of innovators for the intellectual property asset filing and the issuance, as encompassed by the recitation of amended claim 86 set forth above. As discussed above, neither *Hunter* nor *Eggleston* describes or suggests issuance gifts given to innovators for the issuance of intellectual property assets, let alone tracking issuance gifts. Accordingly, *Hunter* and *Eggleston* do not teach, suggest, or describe this recitation of amended claim 86.

Independent Claim 92

Claim 92 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. The teachings of *Hunter* and *Eggleston*, separately or together, do not teach, suggest, or describe each and every recitation of claim 92. As amended, claim 92 recites, *inter alia*,

“logic configured to receive a notification that an intellectual property asset filing has occurred, the intellectual property asset filing based at least in part on an innovation disclosure of the plurality of innovation disclosures associated with the at least one innovator of the plurality of innovators;
logic configured to, in response to receiving the notification that the intellectual property asset filing has occurred, process a filing gift for the at least one innovator of the plurality of innovators;
logic configured to receive a notification that an issuance associated with the intellectual property asset filing has occurred;
logic configured to, in response to receiving the notification of the issuance, process an issuance gift for the at least one innovator of the plurality of innovators.”

As described above, *Hunter* does not describe or suggest receiving any notifications that an intellectual property asset filing has occurred, let alone, processing a disclosure gift for at least one innovator in response to receiving the notification that the intellectual property asset filing has occurred. Furthermore, there is absolutely no discussion of receiving any notifications that an intellectual property asset issuance has occurred or processing an issuance gift for at least

one innovator in response to receiving the notification that the intellectual property asset filing has occurred of receiving a notification that an intellectual property asset filing has occurred. On the other hand, *Eggleston* describes a system for providing incentive programs over a computer network in which a host may provide sponsoring companies with the capability to buy prepackaged or self-built incentive programs. However, *Eggleston* also fails to disclose processing disclosure gifts for at least one innovator in response to receiving a notification that an intellectual property asset filing has occurred. In addition, *Eggleston*, like *Hunter*, fails to disclose or suggest processing an issuance award for at least one innovator in response to receiving a notification that an issuance associated with the intellectual property asset filing has occurred, as encompassed by amended claim 92. Therefore, *Hunter* and *Eggleston* do not teach, suggest, or describe this recitation of amended claim 92.

In addition, *Hunter* and *Eggleston* do not, separately or together, teach, suggest or describe the recitations of amended claim 92 for tracking the “filing gifts and the issuance gifts given to the at least one innovator of the plurality of innovators for the intellectual property asset filing and the issuance.” As described above with respect to claim 86, *Eggleston* has nothing to do with intellectual property related matters, and therefore, cannot teach, suggest, or describe tracking disclosure gifts and issuance gifts given to the at least one innovator of the plurality of innovators for the intellectual property asset filing and the issuance, as encompassed by the recitation of amended claim 92 set forth above. Further, since independent claim 92 includes recitations similar to claim 86, Assignee respectfully submits that claim 92 is also allowable over the combined teachings of *Hunter* and *Eggleston* at least for the reasons discussed above with regard to amended claim 86. Accordingly, *Hunter* and *Eggleston* do not teach, suggest, or describe this recitation of amended claim 92.

Independent Claim 98

Claim 98 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. Assignee respectfully submits that the combined teachings of *Hunter* and *Eggleston* do not teach, suggest, or describe each and every recitation of claim 98. As amended, claim 98 recites, *inter alia*,

“receiving, through the computer, a notification that an intellectual property
asset filing has occurred, the intellectual property asset filing

based at least in part on an innovation disclosure of the plurality of innovation disclosures associated with the at least one innovator of the plurality of innovators;

in response to receiving the notification that the intellectual property asset filing has occurred, processing, through the computer, a filing gift for the at least one innovator of the plurality of innovators;

receiving, through the computer, a notification that an issuance associated with the intellectual property asset filing has occurred;

in response to receiving the notification of the issuance, processing, through the computer, an issuance gift for the at least one innovator of the plurality of innovators;

tracking, through the computer, the filing gift and the issuance gift given to the at least one innovator of the plurality of innovators for the intellectual property asset filing and the issuance.”

Since independent claim 98 includes recitations similar to claims 86 and 92, claim 98 is also allowable over the combined teachings of *Hunter* and *Eggleston* at least for the reasons discussed above regarding claims 86 and 92. Accordingly, *Hunter* and *Eggleston* do not teach, suggest, or describe this recitation of amended claim 98.

Claims 87-91, 93-97 and 99-103

Claims 87-91, 93-97 and 99-103 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. Claims 87-91, 93-97 and 99-103 are allowable because they include recitations not taught by the cited references and because these claims depend from allowable independent claims. Accordingly, these claims are also in condition for immediate allowance.

Conclusion

In view of the foregoing amendment and remarks, Assignee respectfully submits that all of the pending claims in the present application are in condition for allowance. Reconsideration and reexamination of the application and allowance of the claims at an early date is solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact Assignee's undersigned attorney at (404) 815-1900.

Respectfully submitted,

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